

INDEX.

	PAGE
Notice.	1
Petition for Writ of Certiorari.....	2
Brief in Support of Same.....	9
Opinion of C. C. A., 3rd Circuit.....	29

IN THE
**Supreme Court of the United
States.**

NEW YORK SCAFFOLDING COMPANY,
Petitioner and Plaintiff below,

VS.

LIEBEL BINNEY CONSTRUCTION CO.
and EGBERT WHITNEY,
Respondents and Defendants below,

PARKINSON & LANE, Esqs.,
Marquette Building,
Chicago, Ill.

Sirs:

YOU WILL PLEASE TAKE NOTICE, that on Tuesday, October 2, 1917, at the opening of the court on that day, we shall present to the Supreme Court of the United States, in its court room, at the Capitol Building, in the City of Washington, D. C., the annexed petition for writ of certiorari and brief accompanying the same, copy of which petition and brief is herewith served on you.

Yours, etc.,

C. P. GOEPEL,
FRANK CHASE SOMES,
Counsel for Petitioner.

The foregoing notice is hereby accepted and delivery of a copy thereof and of a petition for writ of certiorari and brief accompanying the same is hereby acknowledged, this day of _____, 1917.

Counsel for Respondent.

IN THE SUPREME COURT OF THE
UNITED STATES,

OCTOBER TERM.

NEW YORK SCAFFOLDING COMPANY,
Petitioner and Plaintiff Below.

vs.

LIEBEL-BINNEY CONSTRUCTION COM-
PANY and EGBERT WHITNEY,
Respondent and Defendant Below.

**Petition for Writ of Certiorari to the U. S. Court
of Appeals for the Third Circuit.**

To the Honorable, the Chief Justice and As-
sociate Justices of the Supreme Court of
the United States:

Your petitioner, New York Scaffolding Com-
pany, a corporation organized and existing
under the laws of the State of New York, re-
spectfully represents:

FIRST: That in the case at bar, the U. S. Cir-
cuit Court of Appeals for the Third Circuit, has
ruled that U. S. Letters Patent No. 959,008, to
E. H. Henderson, is invalid for lack of inven-
tion, in a suit filed for infringement of said
Letters Patent, in the Western District of
Pennsylvania, by the plaintiff, the New York
Scaffolding Company, against the defendant, the
Liebel-Binney Construction Company, with the
defendant, Egbert Whitney, intervening (U. S.

Supreme Court Equity Rule No. 37), in the face of a prior adjudication on substantially the same issues, holding said Letters Patent valid and infringed by the U. S. Court of Appeals for the Eighth Circuit, opinion being reported in 224 Fed., 452. (Petition for writ of certiorari to the Eighth Circuit submitted by defendant Whitney denied in 239 U. S., 640.) The device of the defendant, namely, the "Whitney Scaffold Hoist" machine, is identical in both litigations.

In addition to this, the U. S. Circuit Court of Appeals for the Seventh Circuit, in the case of New York Scaffolding Company *v.* Chain Belt Company and Egbert Whitney (opinion appended to Transcript of Record of that case, on a petition for a writ of certiorari submitted to this Hon. Court in that case simultaneously with this petition), held this same patent valid and infringed by the same machine, to wit, the "Whitney Scaffold Hoist" machine, and on substantially the same issue as in the Third Circuit.

There are thus absolutely contrary decisions by the said Courts, the Eighth Circuit and the Seventh Circuit, holding the patent valid and infringed by the "Whitney Scaffold Hoist" machine, against the Third Circuit, holding the patent invalid, on substantially the same issue, and against one and the same defendant.

SECOND. That the Hon. Court of Appeals for the Third Circuit in comparing the Henderson invention with the prior art Murray patent No. 854,959, overlooked the important mechanical distinction which exists in fact, to wit, that

Murray's inverted U frame has its free ends rivettedly secured to the ends of the putlogs or cross beams making one cumbersome structure, incapable of yielding to the strains and stresses resulting from the use of the device by the workmen and heavy materials on the platform, and incapable of convenient dissembling on the completion of the job, and ready reassembling on the new job, whereas, Henderson, in the embodiment shown, inverts the inverted U frame of Murray, and, turning it at right angles to the Murray position, places his putlogs loosely and hingedly therein, producing a scaffold yielding at all parts to the strains and stresses resulting from the use of the scaffolding, thereby rendering the unsafe Murray patent, safe and useful to the practical commercial art. The Court of Appeals for the Third Circuit apparently overlooked the uncontradicted testimony of plaintiff's witnesses (Cavanagh Tr., pp. 101, 102 and 103; no testimony in defense was offered by the defendant, the proofs being closed on the conclusion of plaintiff's case), wherein plaintiff's witnesses pointed out, that, due to the hinge connection resulting from the placing of the putlogs or cross beams *loosely* in the stirrup-like U-shaped frames, the life of the cables was increased, and the platform made adaptable to that "give" and "take" essential to the successful operation of scaffolding platforms used on high buildings, with men working thereon at sometimes thirty and forty stories in height.

THIRD: That when these parties went to trial

in this cause before the District Court for the Western District of Pennsylvania (His Honor, Judge Orr, sitting), the Circuit Court of Appeals for the Eighth Circuit had already held the patent in suit to be valid and infringed by the "Whitney Scaffold Hoist" machine, but the mandate had not yet come down from that Court and as a result no formal decree after mandate had as yet been entered in plaintiff's favor, reversing the decree of dismissal of the U. S. District Court, District of Nebraska, Omaha Division, from which the appeal to the Circuit Court of Appeals for the Eighth Circuit had been taken. After this decree after mandate was entered after the trial before Judge Orr, plaintiff moved for leave to file a supplemental bill against Egbert Whitney, to enable a decree *in personam* to be entered against Egbert Whitney, in order to secure a uniformity of decisions throughout the country against Egbert Whitney himself, co-defendant in all three suits. As such a decree in a patent case is a decree *in personam* and not *in rem*, the filing of the proposed supplemental bill of complaint could not in any way lead to a decree against the Liebel-Binney Construction Company, which was entitled to have the benefit of its own decree. But we respectfully state that the District Court for the Western District of Pennsylvania declined to permit this supplemental bill to be filed, and the Hon. Court of Appeals did not correct this error of the lower court in this regard, making no reference in its opinion thereto. We respectfully urge that this failure to allow the filing of this supplemental bill of complaint acted against the possibility of se-

curing uniformity of decisions against the same defendant, Egbert Whitney, in consonance with the intent and spirit of our jurisprudence.

FOURTH: That an unsettled condition of the litigation exists—with the Seventh and Eighth Circuits holding the patent valid, and the Third Circuit holding it invalid—on the same infringing device and against the same defendant, Egbert Whitney, and brings about a great confusion, in that a decree in one circuit has one force and effect on the real and instigating defendant, Egbert Whitney, whereas, in the two other circuits, the decrees against the same machine and against the same defendant, Egbert Whitney, have a different force and legal effect.

FIFTH: That *Kessler v. Eldred*, 206 U. S., 285, 51 L. Ed., 1065; 27 Sup. Ct. Rep., 611, and *Diamond Co. v. Consolidated Co.*, 220 U. S., 428, 55 L. Ed., 527, 31 Sup. Ct., 444, left questions undetermined by this Honorable Court, which questions are acutely presented in the case at bar, and embrace novel points in the law relating to patents, the early solution of which questions is of the greatest importance to this petitioner and to all those pecuniarily interested in patents throughout these United States.

SIXTH: That the subject matter of this litigation is of great importance to the building trade, and the entire industry is interested in the definite and final decision of this litigation over the Henderson patent in issue.

WHEREFORE, your petitioner respectfully prays:

That a writ of certiorari may be issued out of and under the seal of this court directed to the United States Circuit Court of Appeals for the Third Circuit, commanding the said court to certify and send to this court, on a certain day to be therein designated, a full and complete transcript of the record of all proceedings of the said Court of Appeals in the same case therein, entitled, New York Scaffolding Company v. Liebel-Binney Construction Company and Egbert Whitney, and decided July 3, 1917, to the end that the said case may be reviewed and determined by this court, and that your petitioner may have such other or further relief as to this Honorable Court may seem proper and appropriate.

NEW YORK SCAFFOLDING COMPANY,
Petitioner.
By C. P. GOEPEL,
F. C. SOMES.

I hereby certify that I am solicitor and of counsel for the petitioner herein, New York Scaffolding Company; that in accordance with the request of said petitioner, the foregoing petition has been prepared; that the allegations contained in said petition are true, to the best of my knowledge and belief; and that said petition is, in my opinion, well founded in law, as well as in fact.

C. P. GOEPEL,
F. C. SOMES,
Counsel for Petitioner.

IN THE SUPREME COURT OF THE
UNITED STATES,

OCTOBER TERM.

NEW YORK SCAFFOLDING COMPANY,
Plaintiff-Petitioner,

VS.

LIEBEL-BINNEY CONSTRUCTION COM-
PANY and EGBERT WHITNEY,
Defendants-Respondents.

**Brief in Favor of Petition for Writ of Certiorari
to the U. S. Court of Appeals for the Third
Circuit.**

To the Honorable Chief Justice, and Associate
Justices of the Supreme Court of the United
States:

FIRST: The defendant's device in the Third Circuit is the "Whitney Scaffold Hoist" machine, a device identical in all respects with that in issue in the litigation entitled New York Scaffolding Co. v. Egbert Whitney, 224 Fed., 452, 140 C. C. A., 138, wherein the Court of Appeals for the Eighth Circuit, held the patent valid and infringed by this same defendant, Egbert Whitney, concluding in sweeping language:

"Let a decree for an accounting and for an injunction against the manufacture and sale by the defendant, Whitney, or his agents, of his hoisting device and hoisting frame for use or

sale in the combination of claim 1 or of claim 3 of Henderson's patent, or for any other purpose than use in a scaffold made by laying a plank or planks on the lower bars of two of his hoisting frames placed with their edges to the wall of the building, be granted."

This opinion was before the Court of Appeals for the Third Circuit, but this same patent in suit was declared invalid on substantially the same issues (the opinion of the Court of Appeals is found at the end of the transcript of record forming the basis for this petition herein, and a printed copy of the opinion is appended hereto for the convenience of the court). Hence, on substantially the same issues, there are two decisions of different Circuit Courts of Appeal diametrically opposite to each other.

SECOND: The claims in suit of the Henderson patent are for *combinations*, and thus these embrace an entirety and read as follows:

"1. A scaffold consisting in the combination of cross beams, floor pieces extending between such beams, and a hoisting device associated with each end of each beam, each hoisting device consisting of a continuous U-shaped metal bar extending around the under side of and upward from the associated beam, and a hoisting drum rotatably supported by the side members of such bar.

3. A scaffold consisting of a plurality of U-shaped bars arranged in pairs, a cross beam laid in and extending between each pair of such U-shaped bars, a floor laid upon said cross beam, a drum rotatably supported between the upwardly extending side members of each of said U-shaped bars, and means for controlling the rotation of said drum."

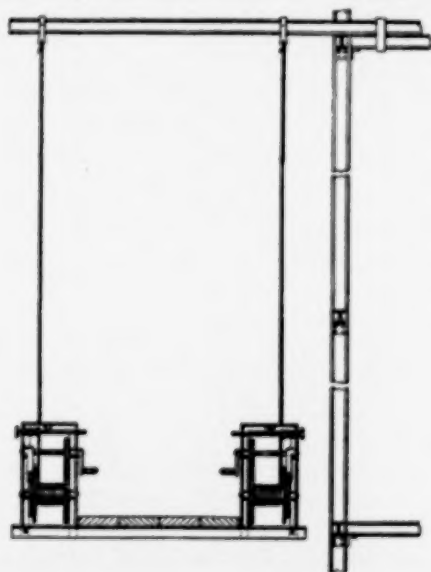
In these claims, the principle of the invention is a unit, with a novel co-operative law underlying the assembling of the parts composing the claims, which the Eighth Circuit recognized, and the true test to ascertain whether such a *combination* claim is valid, is not to find separate elements of the claim in the prior art, as the Court of Appeals for the Third Circuit did, for if this were allowed "not one patent of the kind in a thousand of modern date could be held valid" (*Parks v. Booth*, 102 U. S., 96, 104, 26 L. Ed., 54, 57), but is to find the "entirety," the "co-operative law," the "spirit of the thought" that vivifies the invention, in the prior art (*Cantrell v. Wallick*, 117 U. S., 689, 29 L. Ed., 1017; 6 S. C., 970). Unless such antiquity of mode of operation is found established by the prior art, the combination remains unanticipated by it. Whether the combination *per se* presents invention, depends upon considerations as to the increase of effectiveness of the entirety, and whether its usefulness is increased. (*Seymour v. Osborne*, 78 U. S., 11 Wall., 516; 20 L. Ed., 33; *Loom Co. v. Higgins*, 105 U. S., 580, 26 L. Ed., 1177.)

Tested by these principles, the Henderson combination stands as *patentable* over the Murray patent No. 854,959 (Transcript of Record, additional transcript page 23), and it was so held by the Court of Appeals for the Eighth Circuit, and by the Court of Appeals for the Seventh Circuit. The same unit—the principle of the invention—is not found in Murray, and the effectiveness of Henderson over the Murray patent is considerable.

The Henderson invention departs from the prior art in that it places the putlogs or cross beams *loosely* in the stirrups formed by the U-

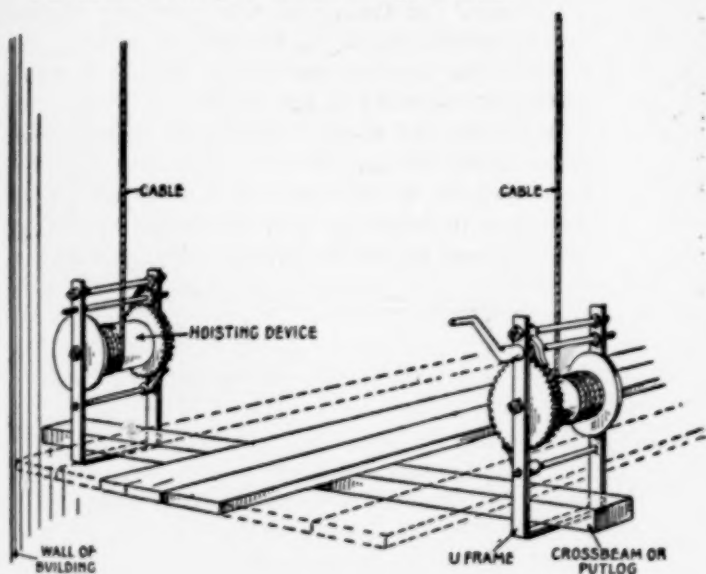
shaped frames, and provides thereby a "hinge connection" at the connections, so that the entire platform placed on the hinged putlogs may yield to the various strains and stresses to which a mason's scaffold is subjected.

This *loose* connection enables a separate shipment of the elements composing the combination, to the place of use, their convenient assembling and also dismantling, and the hinge connection secures long life to the cables. (Tr., p. 103.)



The Murray prior art patent has the free ends of its inverted U-frame secured to the putlogs or cross-beams, making one cumbersome structure difficult to move from place to place, rigid and unyielding, focussing all strains and stresses to the rivet, forming the connection, thus rendering the scaffold insecure and dangerous.

But Henderson provides a hinge action.



It is this hinge action of Henderson resulting from the loose connection, and the consequent yielding platform of Henderson which constitutes the "spirit of the thought" that underlies the Henderson combination, and binds the elements of the combination into a co-operative law, forming the entirety of the combination, which the Court of Appeals for the Third Circuit failed to perceive, since it says:

"He provided a loose and unfastened putlog in place of the fixed and fastened putlog of Murray, and lessened the fixity and rigidity of the whole platform, thereby correspondingly lessening the security of the workmen, which is just the opposite of what was pressed throughout the argument as the important consideration to induce

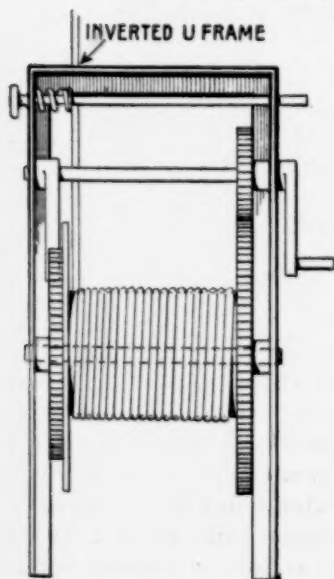
masons to work with heavy materials upon swinging platforms."

Of course, to induce masons to work with heavy materials upon swinging platforms, such platforms must first of all be safe and reliable, and to the ordinary layman and observer, it would seem that the safest and most reliable scaffold is one secured fixedly and rigidly in all its connecting parts. So, Murray in his patent No. 854,959, entertained this idea of rigidity and fixity. But, the commercial machines of the Patent Scaffolding Company, which the Court of Appeals for the Third Circuit referred to by saying that this company advertises only the Murray, and that of the machines it put out and rents seventy percent of the scaffolds are Murray devices, are *not rigid and fixed*, as shown in the Murray patent No. 854,959, but are *loosely* connected, in a *hinged* manner, *yielding* and *giving* at their connection, and are embraced by the broader or generic claim 1 of the patent in suit, which speaks of having the cross-beams or putlogs "associated with the U-frames" in contrast with claim 3, which speaks of the cross-beams being "laid in." It will, therefore, be seen, that the Honorable Court of Appeals for the Third Circuit failed to preceive that subtle distinction so often found in the consideration of combination claims, and which underlies the Henderson patent, as held by the Eighth Circuit, in 224 Fed., 452. But it is right here that the primary invention and central idea of Henderson is brought out boldly in relief. He saw what the prior art did not see. He evolved by the exercise of his imagination and creative faculties, a "combination" or "co-operative law" which

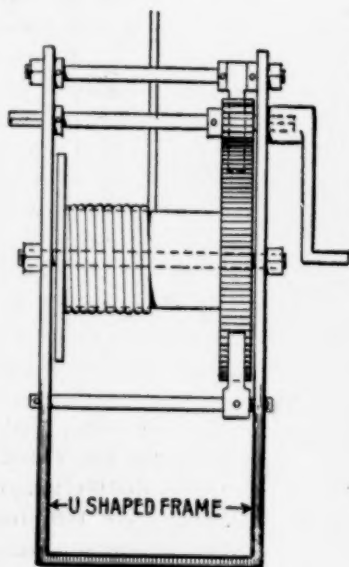
permeates this structure, and which embodied in the use of 70% of the scaffolds, turned the Murray rigid and unsafe structure into a successful platform scaffold.

It is said by the Court of Appeals for the Third Circuit that the difference in construction is small indeed, but is this the fact? Mechanically speaking, Henderson in his embodiment of his patent, did these things over Murray:

1. he took the inverted U-shaped frame, and turned it up side down,

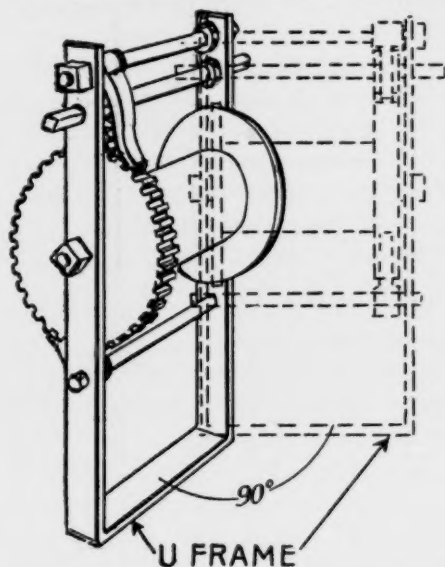


MURRAY

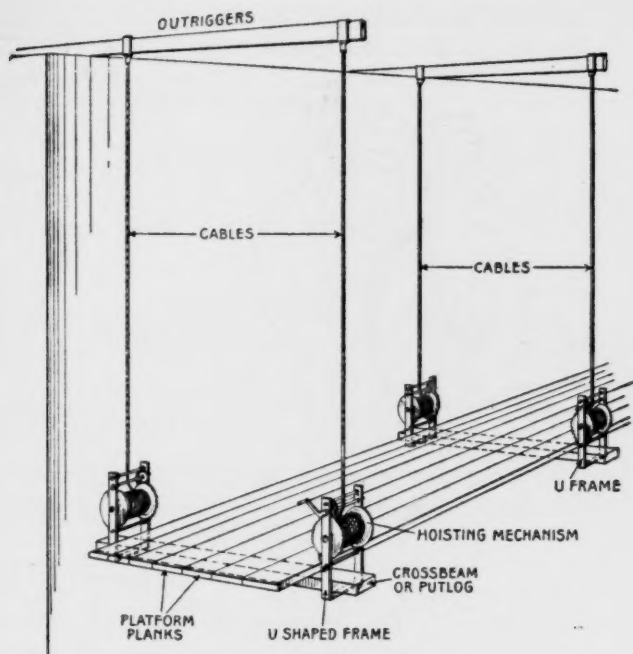


HENDERSON

2. he then changed it to a position at right angles to the Murray position,



3. he "laid in" the cross-beam or putlog into the U-shaped frame or stirrup.
(Claim 3.)



It is also said that the difference in result is a small saving of space upon the platform, but Henderson by this complete reconstruction, did something more than a mere saving of space, he provided a "hinge" connection, and a consequent *yielding* between the parts, whereby the strains and stresses resulting from the use of the scaffolding machines are not focussed to the connecting rivets as in Murray, but are taken up by each element of the combination—the U-shaped frame assuming its quota, the cross-beam its share, and the platform planks their portion.

Such is the increase in effectiveness of these known elements by their new union, that these

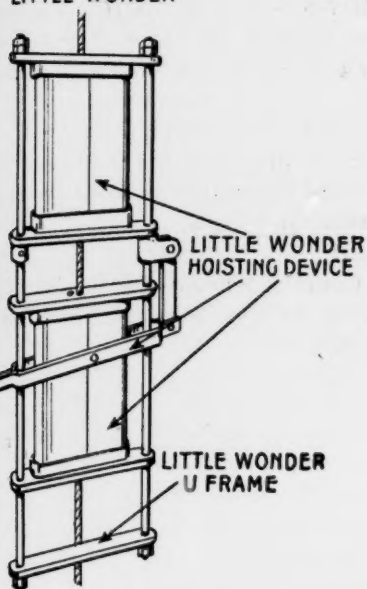
old parts in the Murray patent, when used in the manner of the Henderson combination, vivified the prior art, and formed the basis of the first *successful platform* type of scaffolding machine ever used.

Failure to apperceive the underlying invention of Henderson over the prior art, led the Court of Appeals for the Third Circuit, to premises which necessitated a conclusion contrary to the validity of the patent in suit.

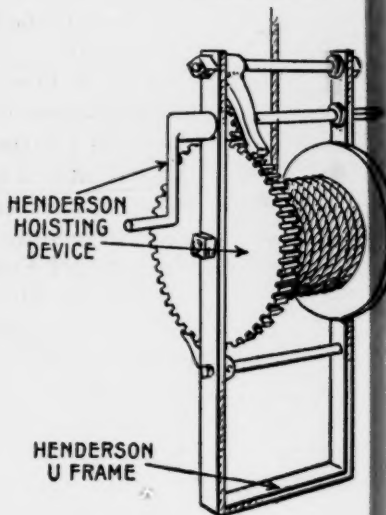
The Honorable Court of Appeals for the Eighth Circuit, 224 Fed., 452, as also in its later decision, as also the Honorable Court of Appeals for the Seventh Circuit, found the patent valid over this same Murray patent No. 854,959.

There are, therefore, conflicting decisions on the same issues and on substantially the same facts, and in view of the fact that these decisions go also against one and the same defendant, Egbert Whitney, incongruous decisions in different circuits exist, such as should induce this Hon. Court to allow the petition to enable the conflict to be clarified and become harmonized.

LITTLE WONDER



HENDERSON



The principle of the invention is a unit, and invariably the modes of its embodiment in a concrete invention may be numerous and in appearance very different from each other. (Robinson on Patents, Sec. 485.) And if there be among pre-existing devices anything presenting a superficial resemblance to the Henderson scaffold, the resemblance is of the kind characterized by this court in the Richardson Valve case (*Consolidated Safety Valve Co. v. Crosby Steam Gauge & Valve Co.*, 113 U. S., 157, 171; 28 L. Ed. 939, 943; 5 Sup. Ct. Rep. 513, 521), in which the court, speaking of certain prior devices, said:

“Likenesses in them, in physical structure, to the apparatus of Richardson, in important par-

ticulars, may be pointed out; but it is only as the anatomy of a corpse resembles that of a living being. The prior structures never affected the kind of result by Richardson's apparatus, because they lacked the thing which gave success."

THIRD: This incongruity presents the unique condition, namely, one circuit holding the same Egbert Whitney free to make, use and sell "Whitney Scaffold Hoist" machines, and two circuits holding the same Egbert Whitney as an infringer for making, selling or using the same machine in the Henderson combination.

That the trial court, as also the Hon. Court of Appeals for the Third Circuit, should have allowed the filing of the supplemental bill of complaint as against the same Egbert Whitney, defendant in the case of New York Scaffolding Co. *v.* Whitney, 224 Fed. 452, to enable plaintiff to get a decree *in personam* against Egbert Whitney, and thus secure a uniformity of decisions throughout the country as far as Egbert Whitney is concerned, follows from a statement of the facts. (Hart Steel Co. *v.* Railroad Supply Co., 37 Sup. Ct. Rep. 506.) Had this been allowed, that discordancy that now exists could have been prevented, as then this same Egbert Whitney, the instigating infringer, would not now be able to be free of the consequences of acts held to be wrongful by the Circuit Courts of Appeals for the Seventh Circuit and for the Eighth Circuit, whatever may be the situation as regards his co-defendant, the Liebel-Binney Construction Co. The filing of the proposed supplemental bill of complaint could not in any way have led to a decree against the Liebel-Binney Construction Company, which is and was entitled to an independent adjudication.

FOURTH: But to avoid the existence of conflicting decrees with respect to one and the same person, namely, Egbert Whitney, who is a defendant in each of the three litigations referred to, the proposed supplemental decree should be filed and proceedings had with respect thereto. That a claim in a patent case is one *in personam* and not *in rem*, has been held by the Circuit Court of Appeals for the Seventh Circuit in *Rubber Tire Wheel Co. v. Milwaukee Co.*, 154 Fed., 358, 363, 83 C. C. A. 336, 341, in which Judge Baker said, after showing that certain courts held the Grant patent valid, while the Circuit Court of Appeals for the Sixth Circuit held it invalid:

"The case in the Court of Appeals for the Sixth Circuit was not a proceeding *in rem*. The defendant in that particular suit has a decree on which, if he were again sued for infringement of the Grant patent, he could base a plea of *res adjudicata*. That plea would be as good in the other circuits as in the Sixth. No other member of the public could plead that decree in any circuit. The right conclusion of law from the facts found is that, so far as the parties to the contract in suit are concerned, the patent is valid throughout the United States, and is enforceable against everyone who is not able to shield himself behind an erroneous decree. If any inference of fact (or prophecy) was to be drawn from the facts found, it should have been that the Court of Appeals for the Sixth Circuit will not exempt other members of the public from the monopoly of the Grant patent."

From this, it might follow that the Third Circuit decree is good "in the other circuits" as to the three-fold Whitney.

In the case at bar, the patent has been three times held valid and infringed against the same defendant, Egbert Whitney, and once declared invalid in favor of this same defendant, Egbert Whitney. In the words of Judge Baker in the Rubber Company case, the Courts in the Third Circuit will exempt this defendant Whitney from the monopoly of the Henderson patent held to exist against him in the Seventh and Eighth Circuits. And, as Judge Baker says, "That plea would be as good in the other circuits as in the Sixth."

FIFTH: The keen question as a result of the incongruity of decisions, therefore, arises, whether the defendant Egbert Whitney, being exempted by the Third Circuit, is equally exempted in other circuits, as intimated in the Rubber Company case.

Some concern, on a similar question, seems to have been caused to the Court of Appeals for the Second Circuit in the litigation on the Grant Tire (89 C. C. A., 582, 584; 162 Fed., 892, 894), on the question of excluding structures held not to infringe by the Circuit Court of Appeals for the Sixth Circuit, from the operation of its decree, but it expressly refrained from passing directly on the issue, and this Hon. Court in affirming its decision, 220 U. S., 428, 445, 55 L. Ed., 527, 536, 31 S. C., 444, 451, said:

"The final contention of the rubber company is that, the Grant patent having been declared invalid by the Circuit Court of Appeals of the Sixth Circuit and by the Circuit Court for the District of Indiana in the Seventh Circuit, the rubber company should not have been enjoined

from the handling or sale of tires manufactured in the Sixth and Seventh Circuits, and cites *Kessler v. Eldred*, 206 U. S., 285, 51 L. Ed., 1065, 27 Sup. Ct. Rep., 611."

This Hon. Court, however, did not decide this point.

In *Kessler v. Eldred*, 206 U. S., 285, 51 L. Ed., 1065, 27 Sup. Ct., 611, this Court said:

"It may be that the judgment in *Eldred v. Kessler* will not afford Breitwieser, a customer of Kessler, a defense to Eldred's suit against him. Upon that question we express no opinion. Neither it nor the case in which it is raised are before us."

In the case at bar, not alone did Whitney assume the defense of this suit, as Kessler assumed the defense of Breitwieser, but Whitney expressly intervened and became an actual party defendant to this suit. Thus, it may be that the decree after mandate of the Eight Circuit will not afford the plaintiff a judgment against the Liebel-Binney Company, which is entitled to raise its own defenses, but has Whitney the right to be exempted by the Third Circuit, and following *Kessler v. Eldred*, wherein it is stated, that Eldred has the duty to "recognize and yield to that right everywhere and always," must the New York Scaffolding Company "recognize and yield to that right everywhere and always," and has Whitney the right "everywhere and always" to infringe in the face of the decrees of the Seventh and Eighth Circuits?

As between the New York Scaffolding Co. and the Liebel-Binney Construction Company,

there can be no estoppel growing out of the earlier judgment between New York Scaffolding Company and Egbert Whitney (*Lyon v. Perin Mfg. Co.*, 125 U. S., 698; 31 L. Ed., 839; 8 Sup. Ct. Rep., 1024), but we respectfully urge that there is an estoppel as a result of the Eighth Circuit decision against this same Egbert Whitney, who, voluntarily became a party defendant in the Third Circuit. It appears that prior to *Kessler v. Eldred*, there was no case holding directly that a judgment in the manufacturer's favor on an issue of validity or infringement entitled him to proceed with his business and protected him and his customers against interference by the patentee in respect to the thing covered by the decree, though there were cases which impliedly recognized that principle. (*Ide v. Ball Engine Co.*, 31 Fed., 901; *National Cash Register Co. v. Boston Cash Indicator Co.*, 41 Fed., 51; *Allis v. Stowell*, 16 Fed., 783; *Kelly v. Ypsilanti*, 44 Fed., 19.) And it now appears, even after *Kessler v. Eldred*, that the point in the case at bar, has been left undecided by this Hon. Court.

We respectfully submit that this question is unique in the law of patents, and finds no controlling authority in the books. In *Kessler v. Eldred*, this court said "The industry of counsel has not discovered any decision on the exact question presented in the certificate."

Rubber Tire Wheel Co. v. Goodyear Tire & Rubber Co., 232 U. S., 413; 58 L. Ed., 663; and

Hart Steel Co. v. Railroad Supply Co., 37 Sup. Ct. Rep., 506,

do not squarely decide the point herein.

SIXTH: Should this Honorable Court decline to pass on the question herein so acutely presented, a confusion will result, and as a result the plaintiff may be mulcted of its hard earned victories in the Seventh and Eighth Circuits. What might be an erroneous decision of the Third Circuit, may draw with it consequences of far-reaching effects, much to the great loss and irreparable injury of the plaintiff herein, and present to the scaffolding industry, and to that great mass of pursuits dependent on patent properties, the case of an infringer held to have committed wrongful acts by the Seventh and Eighth Circuits, free to continue his spoliation, on account of his exemption by the Third Circuit.

Conclusion.

We, therefore, respectfully urge, that the petition should be allowed, because,

1. Conflicting decisions on the same issues are extant between the Seventh and Eighth Circuit Courts of Appeals, on the one hand, and the Court of Appeals for the Third Circuit, on the other hand.

2. That novel questions of patent law require a decision by this Honorable Court, which questions were left undecided in *Kessler v. Eldred*, 206 U. S., 285, 51 L. Ed., 1065, 27 Sup. Ct., 611, and *Diamond Co. v. Consolidated*, 220 U. S., 428, 55 L. Ed., 527, 31 Sup. Ct., 444).

3. The Court of Appeals for the Third Circuit should have allowed the filing of a supplemental bill of complaint against the same

defendant, Egbert Whitney, so as to secure uniformity of decisions as against him, whatever may be its own conclusion for or against the Liebel-Binney Construction Company.

4. That the Court of Appeals failed to apply the law of "combination" to the facts of the case at bar, and, failing to do so, ran counter to the Seventh and Eighth Circuits, and to the fundamental law relating to patents.

5. We respectfully ask for the allowance of this petition, as also the petitions filed in the cases of the Seventh and Eighth Circuits.

Respectfully submitted,

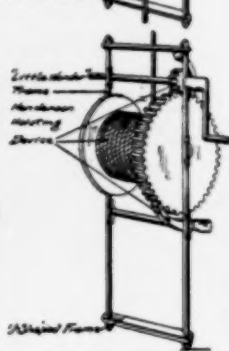
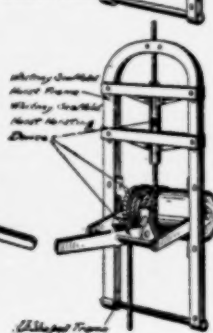
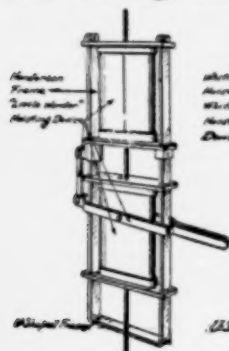
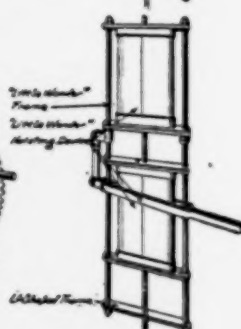
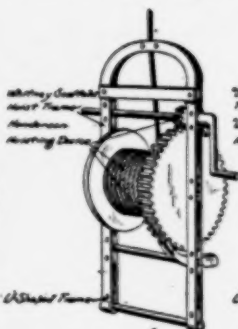
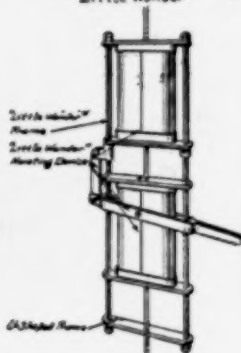
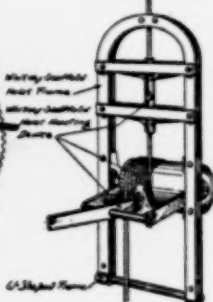
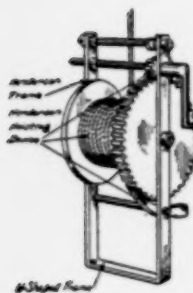
C. P. GOEPEL.
F. C. SOMES.

Interchangeability of Hoisting Devices

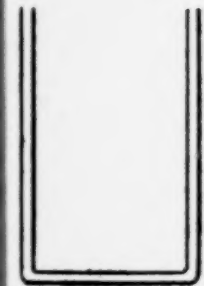
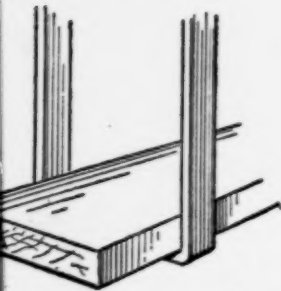
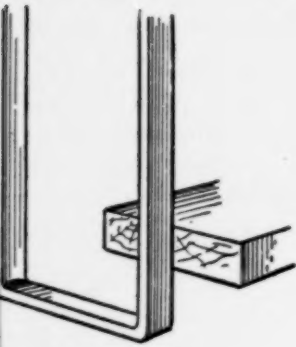
Henderson

Whitney Scaffold
Hoist

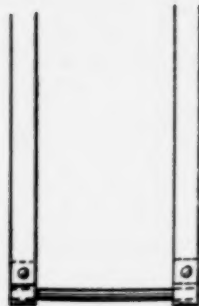
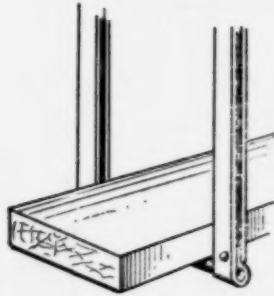
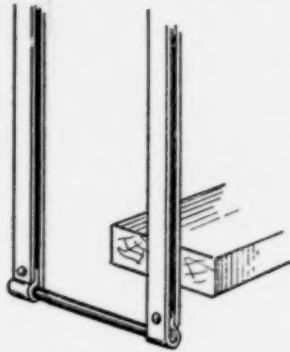
Little Wonder



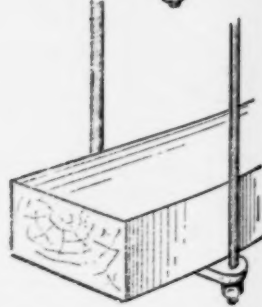
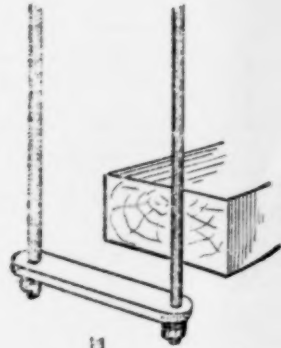
*Henderson
U-Frame*



*Whitney Scaffold
Hoist Machine Frame*



*"Little Wonder"
U-Frame*



IN THE
UNITED STATES CIRCUIT COURT OF
APPEALS,

FOR THE THIRD CIRCUIT.

NEW YORK SCAFFOLDING COMPANY,
Complainant-Appellant,

vs.

LIEBEL-BINNEY CONSTRUCTION COM-
PANY,
Defendant-Appellee.

Appeal from the District Court of the United
States for the Western District of Pennsyl-
vania.

Before—BUFFINGTON, McPHERSON and WOOLLEY,
Circuit Judges.

WOOLLEY, *Circuit Judge:* This is a suit for infringement of Letters Patent No. 958,008, issued to E. H. Henderson, May 24, 1910, and is here on the plaintiff's appeal from a decree of the District Court dismissing the bill on the ground of invalidity of the patent.

The patent is for scaffold supporting means. The claims in issue are 1 and 3. The alleged infringing scaffold used by the defendant was known as the Whitney scaffolding device, manufactured and leased by Egbert Whitney under a junior patent. (Letters Patent No. 998,270 to Whitney.)

In the erection of modern steel frame structures, contractors have found it more economical to rent scaffolds than to buy them. This suit is a part of a controversy between rival scaffold renting concerns. In other litigation instituted by this plaintiff against another defendant, involving the validity of the same claims of the Henderson patent and infringement by the same device of the Whitney patent, the Circuit Court of Appeals for the Eighth Circuit, reversing the District Court for the District of Nebraska, held the claims valid and infringed. *New York Scaffolding Co. v. Whitney*, 224 Fed., 452. In reaching an opposite conclusion in this case upon precisely the same issues and upon substantially the same facts, the learned District Judge hesitated, as do we, in disturbing the force of a decision of a court of co-ordinate jurisdiction and in preventing uniformity of decision by yielding to his own convictions. Yet we feel this is a case where comity, being a rule of convenience intended to persuade, not to command (*Mast, Foos & Co. v. Stover Mfg. Co.*, 177 U. S., 485, 489), should not prevail against an opposite judgment when based upon clear conviction.

The matters which induced the District Court to its judgment, holding invalid a patent previously declared valid by another court, are fully set forth in its opinion, Fed., . These appeal to us with like convincing force. We shall consider them briefly.

In determining whether Henderson's device was a contribution to the art, involving invention, though narrow, or was merely a departure from the art by formal changes in prior devices, we must inquire what Henderson did and what problem he solved.

Scaffolds are as old as buildings; and scaffolds of different types have conformed time out of mind to the types of buildings upon which they were used. When buildings were low, scaffolds likewise were low, and were constructed along lines of greatest convenience, namely from the ground up. When structures increased in height, scaffolds likewise increased in height to a point where the elements of cost and danger induced a change. Then instead of being built from the ground upward they were suspended from the roof downward. When this change was found expedient, the art went for information to other arts in which scaffolds, by reason of their peculiar uses, had never been built upon the ground but had always been suspended from above. Among these was the seaman's art, in which was found the boatswain's chair, a simple contrivance made of a board with ropes through each end after the manner of a child's swing, which converge toward and are connected with a main rope slung from the mast-head or cross-tree, and passed through an overhead block and returned to the operator, by which he raised or lowered his position along the mast. Then there was the painter's stage or hanger, which is nothing more than a longer board, the ends of which are attached to ropes suspended from the ship's rail, capable of being raised and lowered from above or by blocks from below, and used by sailors when painting the ship's sides. The painter's stage was brought to land and conveniently used upon buildings. It consisted of a plank or planks used as a platform resting on cross-bars, the ends of which were held by ropes passed through blocks, which in turn were suspended from large

metal hooks so shaped as to securely grasp the roof of the building. This platform was readily adjusted by block and fall to any elevation.

This crude but much used device was improved by Bowyer and Casperson in their Patent No. 382,252 (1888) by arranging in one structure an enlarged cross-bar or putlog and a drum by which to operate the overhand block and fall and elevate and lower the platform which extended from one putlog to the other.

Platforms of both the crude and improved types were sufficiently steady for sailors and painters who did their work while sitting, but they were not sufficiently firm and steady for the heavier and more active work of bricklayers. As the demand for overhanging scaffolds increased with the increasing height of modern buildings, Clark (Letters Patent No. 673,384—1901), disclosed a mason's platform for such buildings by hanging perforated metal ribbons or strips in pairs from projected out-riggers, attaching putlogs to each pair, and suspending platforms on the putlogs. The platform was adjusted by pinning the putlogs at different positions in the perforations. Foster secured a patent (No. 763,874—1904) for substituting steel cables for the metal ribbons and bolt clamps for the pin fastenings of Clark, which, though held invalid by this court for want of patentable invention (Fed.,

), was a scaffold in the art prior to Henderson. Scaffolds made like Clark and Foster in multiple pairs were found to possess rigidity, but they were adjustable only by changing the putlog sustaining bolts and pins, with loss of time and risk of injury. Cavanaugh overcame these difficulties by a patented device (No. 796,807—1905) for elevating scaffolds of this

type by drums positioned on the out-riggers but operated by chains suspending loosely to the platform. Murray (No. 854,658—1907), improved upon Cavanaugh by changing the position of the drums from the projecting out-riggers to the platform. The hoisting mechanism of Murray consists of a drum with bearings mounted in upright arms of a rectangular metal frame connected and stiffened at the top and bottom by metal rods. The metal frame serves the double purpose of holding the drum in position and of affording a place for engagement with a putlog. To the lower part of the metal frame is rigidly attached one end of a putlog, the other end being similarly attached to the metal frame of another like hoisting mechanism. The drums in pairs are then connected with the pairs of steel cable of Foster. The platform extending from putlog to putlog may then be raised or lowered by winding or unwinding the drums in pairs. In this arrangement the drum frames are placed edgewise the building. This is to be noted because it is the principal thing which, it is claimed distinguishes Murray from the patent in suit.

This was the art when Henderson entered it. Henderson took the drum of Murray, positioned it in a drum frame in the same way and for the same purpose, but he made the frame U-shaped instead of rectangular, and changed the position of the frame and drum from edge to the building to flat with the building, thereby permitting a putlog to be loosely placed and held within the bend of the U. Much stress has been laid in this and other litigation on this difference in position of the drum and manner of engagement of the putlog. In this difference patentable invention is claimed, and has been found (226 Fed.,

459). This is the only difference we discern between Murray and Henderson. We are not satisfied that by this difference Henderson made any improvement, patentable or otherwise. He provided a loose and unfastened putlog in place of the fixed and fastened putlog of Murray, and lessened the fixity and rigidity of the whole platform, thereby correspondingly lessening the security of the workmen, which is just the opposite of what was pressed throughout the argument as the important consideration to induce masons to work with heavy materials upon swinging platforms. But however that may be, the evidence is that although Henderson followed Murray and claims to have improved upon his device, the Patent Scaffolding Company advertises only the Murray device, and seventy percent of the scaffolds it puts out and rents are the Murray device.

We do not see what problem was presented to and solved by Henderson. He did what Murray had already done, but did it in a different way. Patentable invention does not reside in mere difference, either of construction or result. The difference in construction is small indeed, involving nothing more than mechanical skill. The difference in result is a small saving of space upon the platform. This saving does not appear to have been demanded before the patent or valued after it. Finding no new problem presented or solved and no real improvement made, we cannot conceive patentable invention in Henderson's formal changes from the prior art. We are therefore of opinion that Claims 1 and 3 of the patent are void for want of patentable invention.

The decree below is affirmed.

FILED

SEP 28 1917

JAMES D. MAHER

CLERK

No. 712 ~~22~~ 22

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1917.

No.

**NEW YORK SCAFFOLDING CO.,
PLAINTIFF-PETITIONER,**

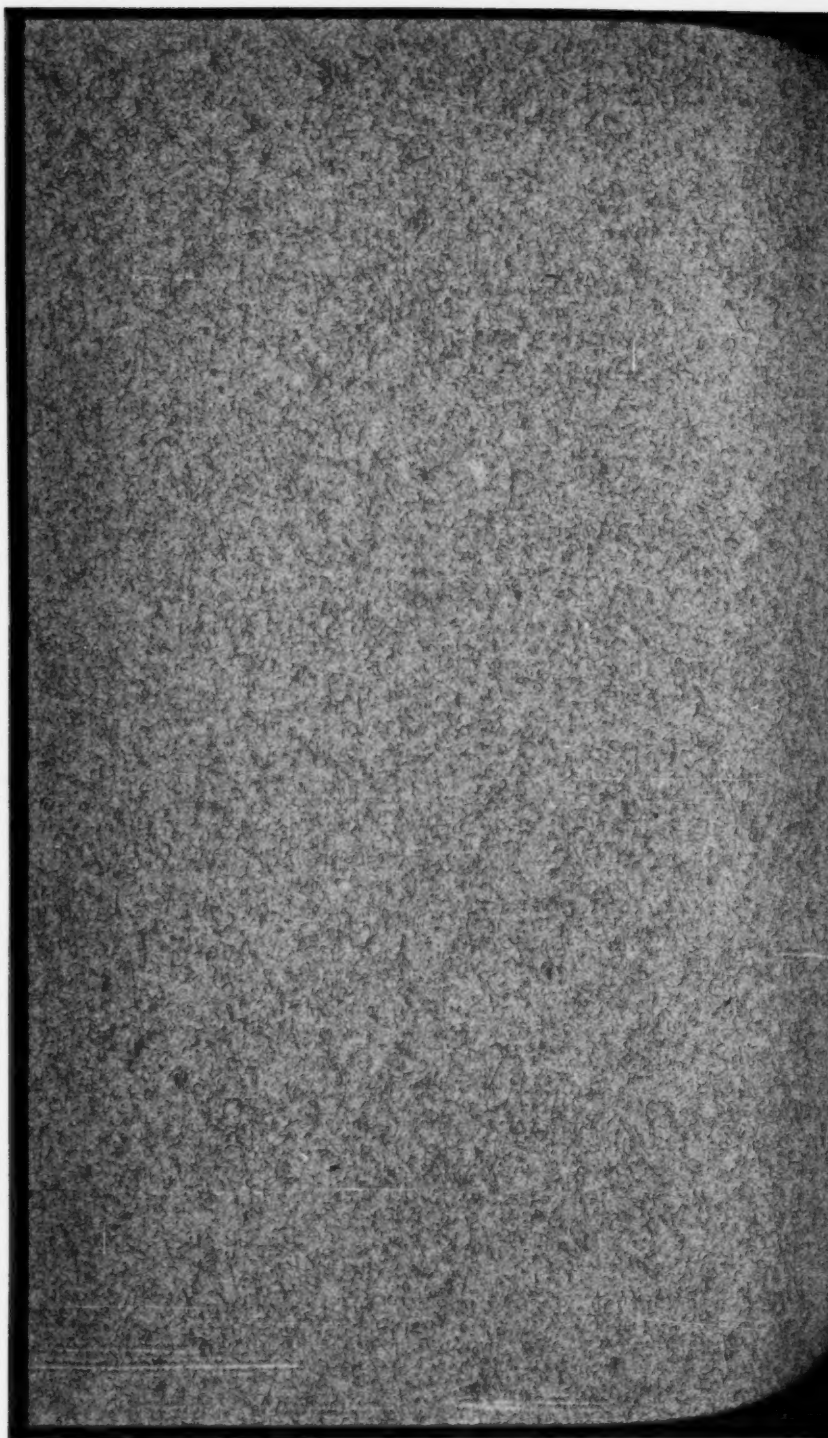
vs.

**LIEBEL-BINNEY CONSTRUCTION CO. AND EGBERT
WHITNEY, DEFENDANTS-RESPONDENTS.**

**PETITION FOR WRIT OF CERTIORARI TO THE U. S.
COURT OF APPEALS FOR THE THIRD CIRCUIT, AND
BRIEF IN SUPPORT OF SAME.**

NOTICE OF CORRECTION OF BRIEF.

**C. P. GOEPEL,
F. C. SOMES,**
For the Petitioner.



IN THE
SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1917.

No.

NEW YORK SCAFFOLDING CO.,
PLAINTIFF-PETITIONER,

vs.

LIEBEL-BINNEY CONSTRUCTION CO. AND EGBERT
WHITNEY, DEFENDANTS-RESPONDENTS.

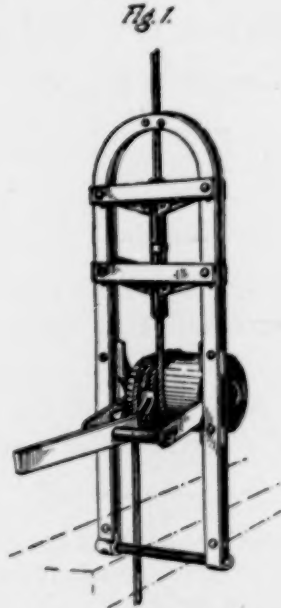
**PETITION FOR WRIT OF CERTIORARI TO THE U. S.
COURT OF APPEALS FOR THE THIRD CIRCUIT, AND
BRIEF IN SUPPORT OF SAME.**

NOTICE.

Sirs:

PLEASE NOTE, that on printed page 19 of the petition for a writ of certiorari and brief in support thereof, in the above entitled cause, a picture of the "Little Wonder" machine appears. The issue in this case is the "Whitney Scaffold Hoist Machine" as clearly stated in the petition and brief. The printer erroneously inserted the cut of the "Little Wonder" machine instead of the cut of the "Whitney Scaf-

fold Hoist Machine." The cut of the "Whitney Scaffold Hoist Machine" should have been inserted and it is as follows:



Whitney Scaffold
Hoist Machine.

The attention of Mr. Wallace R. Lane was called to this obvious error of the printer on Tuesday, September 18th, 1917, and he agreed that the case be considered with this correction and he did not require a new service of the papers.

Respectfully,

C. P. GOEPEL,
F. C. SOMES,
For Petitioner.

To Messrs. Parkinson & Lane, Marquette Building,
Chicago, Illinois.

Service of the foregoing notice by receipt of a copy thereof is hereby acknowledged this 22d day of September, 1917, protesting that there is no warrant for the statement that Mr. Lane agreed as above stated, and that the acknowledgment of service of the brief and petition as served originally September 14th, shall not be taken as applying to any changes since made.

PARKINSON & LANE,
For Respondents.

(35155)